

REMARKS

A. Introduction

Claims 1-5 and 7 were pending and under consideration in the application.

In the Office Action of July 21, 2008 claims 1-5 and 7 were rejected under 35 U.S.C. §103(a), as being unpatentable over Barrett, et al., U.S. 5,301,036 (hereinafter, "*Barrett*") in view of Cariffe, U.S. 6,281,872 (hereinafter, "*Cariffe*").

In response, Applicants seek to amend claims 1, 5, and 7 to clarify that a print-medium image and a print image are displayed superimposed on a rectangular frame representing an outline of a sheet serving as a print medium, and that, in response to a user input, an orientation of the print medium relative to the print image is controlled by at least one of (i) rotating the print-medium image, (ii) rotating the print image, and (iii) simultaneously rotating both the print image and the print-medium image. Support for the amendment is found, at least, at paragraphs 0032-0033 and Figure 3. (Paragraph numbers refer to the application as published as US 2004/0252318.) Accordingly, no new matter is being added.

Applicants submit that the Examiner should enter the offered amendment, because the amendment places the case in condition for allowance. 37 CFR §1.116; MPEP 714.12, 714.13.

B. Rejections under 35 U.S.C. 103(a)

Claims 1-5 and 7 were rejected were rejected as being unpatentable over *Barrett* in view of *Cariffe*.

Barrett discloses a printing system and rotation/page placement techniques wherein a received digital image is rotated at 90 degree increments in order to provide a desired output orientation and placement. *Barrett*'s disclosure relates to reproduction of printed matter compatible with standard print media where the desired output may have various form factors

(e.g., book-form signatures, calendars, etc.). Barrett, abstract, col. 1 lines 34-40, and figure 11.

As the office action concedes, Barrett fails to teach or suggest rotating a captured image data by a rotation angle, where the rotation angle is selectable within a range of one to ninety degrees. Neither does Barrett teach or suggest displaying a print-medium image and a print image superimposed on a rectangular frame representing an outline of a sheet serving as a print medium, and controlling, in response to a user input, an orientation of the print medium relative to the print image by at least one of (i) rotating the print-medium image, (ii) rotating the print image, and (iii) simultaneously rotating both the print image and the print-medium image.

Cariffe is cited for disclosing a rotation angle being selectable within a range of one to ninety degrees. Whether or not this is true, such disclosure fails to cure the deficiencies noted above. As a result, claims 1-5 and 7 are patentable over the combination of *Barrett* and *Cariffe*.

C. Conclusion

In view of the foregoing, it is submitted that claims 1-5 and 7 are allowable and that the application is in condition for allowance. Early notice to that effect is respectfully requested.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,

SONNENSCHN NATH & ROSENTHAL LLP

By /Michael L. Day/

Michael L. Day, Reg. No. 55101
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606-1080
415-882-5064 (telephone)
415-882-0300 (facsimile)
ATTORNEYS FOR APPLICANTS